

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

110466-152116

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on 05/17/2010

Signature /Enoy Lawless/Typed or printed name Enoy Lawless

Application Number

10/815,396

Filed

03/31/2004

First Named Inventor

Christopher J. Lord

Art Unit

2444

Examiner

Zhang, Shirley X.

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

/Yixiong Zou/

Signature

☐

assignee of record of the entire interest.

Yixiong Zou

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

Typed or printed name

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05/17/2010

Registration number if acting under 37 CFR 1.34 _____

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.

Submit multiple forms if more than one signature is required, see below.

☐

*Total of _____ forms are submitted.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Application of:

Christopher Lord et al.

Application No.: 10/815,396

Filed: March 31, 2004

Confirmation No.: 7579

For: CONTROLLING DEVICES ON AN
INTERNAL NETWORK FROM AN
EXTERNAL NETWORK

Examiner: Zhang, Shirley

Group Art Unit: 2444

Customer No.: 31817

Mail Stop Appeal
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Dear Sir:

In the Final Office Action dated February 17, 2010 ("Final Office Action"), claims of the above-captioned application were rejected for a second time. Applicants hereby appeal this decision of the Examiner to the Board of Patent Appeals and Interferences according to 35 U.S.C. §134 and submit a Notice of Appeal in compliance with 37 C.F.R. §41.31 contemporaneously with the present request. Prior to the filing of the Appeal Brief, Applicants respectfully request that a panel of examiners formally review the legal and factual basis of the rejections in the above-captioned application in light of the remarks to follow.

Remarks/Arguments

I. Status of Claims

Claims 1-6, 8, 9, 11, 23 and 25-31 are pending. Claims 7, 10, 12-22, 24 and 32-37 are cancelled.

Claims 1-2, 5-6, 9, 11, 23 and 27-31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 7,406,709 (hereinafter "Maher"), in view of U.S. Patent Application Publication No. 2002/0035699 (hereinafter "Crosbie").

Claim 3 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher and Crosbie, and further in view of U.S. Patent Application Publication No. 2002/0103898 (hereinafter “Moyer”).

Claim 4 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher and Crosbie, further in view of U.S. Patent Application Publication No. 2003/0217136 (hereinafter “Cho”).

Claims 25 and 26 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher and Crosbie, further in view of Cho and the article “UPnP Security Ceremonies Design document for UPnP Device Architecture 1.0” (hereinafter “Ellison”).

Claim 8 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Maher and Crosbie, and further in view of U.S. Patent Application Publication No. 2005/0111382 (hereinafter “Le”).

II. Claim Rejections under 35 U.S.C § 103

In rejecting claims 1-2, 5-6, 9, 11, 23 and 27-31 under § 103, the Examiner has failed to provide a sufficient factual basis to support a prima facie case of obviousness over Maher and Crosbie. In particular, no complete analysis supporting a finding of obviousness was provided, as further detailed below. *See* MPEP 2141.02.

In the Final Office Action, Maher was alleged to be teaching various recitations of claim 1, with the exception of the following recitations:

determining by the intermediary gateway, whether network traffic from the second device is corresponding to a previous secure communication session established when the second device was previously on the internal network, wherein the second device uses an address that is globally routable on the internal and the external networks and therefore said network traffic is valid with respect to the internal network; and

responding by the intermediary gateway, to said network traffic with an error and forcing the second device to re-establish a secure communication session from the external network.

To cure the deficiencies of Maher, the Examiner cited Fig. 1 and paragraph [0008] of Crosbie for teaching the above recitations of claim 1.

In the After-Final Response filed by Applicants on April 12, 2010, hereinafter “After-Final Response,” it was pointed out to the Examiner that paragraph [0008] of

Crosbie explicitly teaches “[i]f, however, the mobile device moves to an access point connected to another subnet ... The mobile device would typically *be required to obtain a new IP address* and so break the previous connection.” See Crosbie, paragraph [0008], (emphasis added). As such, the cited portions of Crosbie contradicts with the recitation of “the second device uses an address that is *globally routable on the internal and external networks*” as recited in claim 1, (emphasis added).

In the Advisory Action mailed April 30, 2010, hereinafter “Advisory Action,” rather than providing any factual support to overcome the rebuttal evidence supplied in the After-Final Response, the Examiner simply stated her position as “Maher did not explicitly disclosed a combination of all the claim elements cited above, with ‘wherein the second device uses an address that is globally routable’ being one of the plurality of elements. Therefore, Applicant’s interpretation of Examiner’s statement is incorrect and Applicant’s argument based on such incorrect interpretation is unpersuasive.”

However, neither the Final Office Action nor the Advisory Action, set forth the relevant teaching of Maher relied upon by the Examiner for teaching or suggesting the recitation of “the second device uses *an address that is globally routable on the internal and the external networks*” as required by MPEP §§ 2141(v) and 706.02(j). And since the Examiner also failed to provide any factual evidence to show Crosbie teaches the aforementioned recitation of claim 1 in light of the After-Final Response, the aforementioned recitation of claim 1 cannot reasonably be said to be present in the asserted combination of Maher and Crosbie.

To support an obviousness rejection, MPEP §2143.03 requires “all words of a claim to be considered” and MPEP § 2141.02 requires consideration of the “[claimed] invention and prior art as a whole.” It remains well-settled law that an obviousness rejection requires at least a suggestion of all of the claim elements. In this case, the Examiner failed to provide any factual support to show that the combined references teach or suggest “the second device uses an address that is globally routable on the internal and the external networks” as recited in claim 1, in light of the rebuttal evidence submitted in the After-Final Response. Therefore, the Examiner failed to support the burden of *prima facie* obviousness in rejection of claim 1.

Independent claims 23 and 27 recite in general similar subject matter to claim 1. Claims 2, 5, 6, 9, 11, and 28-31 depend from one of the claims 1, 23 or 27, respectively, incorporating their respective recitations. Therefore, for at least the above stated reasons, the combination of Maher and Crosbie fails to establish a *prima facie* obviousness rejection for claims 2, 5, 6, 9, 11, 23, 27 and 28-31 as well.

Claims 3, 4, 8, 25 and 26 depend on claims 1 and 23. And the additional references cited against claims 3, 4, 8, 25 and 26 fail to cure the deficiencies of Moher and Crosbie. Therefore, the rejections of claim 3, 4, 8 25 and 26 fails to support a *prima facie* obviousness rejection for similar reasons as previously discussed.

CONCLUSION

In view of the foregoing, Applicant respectfully submits that all pending claims are in condition for allowance. Issuance of the Notice of Allowance is respectfully requested. Please charge any shortages and credit any overages to Deposit Account No. 500393.

Respectfully submitted,
SCHWABE, WILLIAMSON & WYATT, P.C.

Dated: 05/17/2010

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